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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/209,799 12/11/98 HERMELING

R X-10242

EXAMINER

HM22/0409

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INDIANAPOLIS IN 46285

MDEZIE, F

ART UNIT

PAPER NUMBER

1653

23

DATE MAILED:

04/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/209,799

Applicant(s)

Hermeling

Examiner

F. T. Moezie

Group Art Unit

1653

☒ Responsive to communication(s) filed on Feb 15, 220

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 33-40, 42, 75, and 76 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 33-40, 42, 75, and 76 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 20

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### **STATUS OF CLAIMS**

Claims 33-40(amended), 42 and New claim 75 and 76 are pending prosecution in this Office action.

The request filed for **CPA** on February 15, 2001 has been accepted.

In the Preliminary Amendment filed on February 15, 2001 claims 33-40 were amended and claims 75 and 76 were added.

### **COMPLIANCE WITH AMINO ACIDS SEQUENCE DISCLOSURE**

The amino acid sequence disclosures have been approved and entered in the data base. However, the compliance is incomplete for the following reasons:

**Upon compliance with the requirements applicant must also amend the application to provide the SEQ ID NOS in THE SPECIFICATION (at least in the first occurrence), un ALL CLAIMS, EXAMPLES TABLES AND THE CLAIMS.**

Applicant is required to submit an appropriate amendment rectifying this deficiency. In the alternative, a substitute specification under 37 CFR 1.125(b) may be filed. The substitute specification must be accompanied by:(1) a statement that the substitute specification contains no

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new matter; and, (2) a mark-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

#### **NEW GROUND OF REJECTION**

Claims 33-40, 42, 75 and 76 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The addition of the amended subject matter to the claims constitutes New Matter. Further, the added subject matter is not in a verified form.

Claims 40 (amended) and 75 (new), drawn to a composition, are rejected under 35 USC 112, second paragraph, as being indefinite and improper composition claims. The claims are drawn to a compound. The preamble of a claim does not change the content of the claim.

#### **RESPONSE TO APPLICANT**

Applicant's Amendments and Remarks filed February 15, 2001 have been considered but they are not persuasive.

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Applicant may overcome the rejection of the claims under 35 USC 112, first paragraph, New Matter rejection, by a verified showing of the examples in the specification, wherein the results show that the methods would inherently produce the subject matter entered in the claims.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This is a CPA of applicant's earlier Application No. 09/209,799. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to F.T. Moezie at telephone number (703) 305-4508.

*F.T. Moezie*  
F. T. MOEZIE, Ph.D.  
PRIMARY EXAMINER  
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